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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,327	02/20/2004	William F. Behm	SG-20631	6884

7590 08/23/2005

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EXAMINER	
LEE, DIANE I	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/783,327	BEHM ET AL.
	Examiner	Art Unit
	D. I. Lee	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/9/05 (Election of Species)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) *26-33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25 and 34-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *050810*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-41 are presented for examination.

2. Acknowledgement is made that this application is a continuation in part of 10/278,892, now U.S. Pat. 6,736,324; which is a continuation of 09/557,337 filed 04/24/2000, now U.S. Pat. 6,435,408 and also claims priority from Provisional Application 60/350,215 filed 11/02/2001; application 09/557,337 is a division of 09/165,666 filed 10/3/1998, now U.S. Pat. 6,053,405; which is a continuation in part of 08/837,304 filed 04/11/1997, now U.S. Pat. 5,818,091; which is a continuation in part of 08/263,890 filed 06/22/1994, now U.S. Pat. 5,471,039; which is a continuation in part of 08/486,588 filed 06/07/1995, now U.S. Pat. 5,621,200.

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: Figures 1-4 drawn to a lottery ticket and a method for making the same;

Group II: Figure 5 drawn to a lottery ticket redemption apparatus for redeeming a lottery ticket.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims appear generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Mr. McMurry on 8/9/05 a provisional election was made without traverse to prosecute the invention of Group I (Figures 1-4 drawn to a lottery ticket and a method for making the same), which claims 1-25 and 34-41 are directed to the elected group (see attached PTO-413). Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Claims 24 and 34 are objected to because of the following informalities:

(a) Re claim 24, line 3: "a least" should be changed --at least--;

(b) Re claim 34, line 3: "a least" should be changed --at least--.

Appropriate correction is required.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-25 and 34-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,736,324. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the currently claimed structural limitations of the lottery ticket can be found within the Patent claims and the currently claimed limitations of method for making the lottery ticket are obviously encompassed by the structural limitations of the lottery ticket. For example, the substrate of the lottery ticket having a first and a second side and the lottery ticket having a plurality of images (such as play indicia, first bar code, and second bar code are printed on one of the side of the substrate) covered by a scratch-off material are found within the Patent claims. Wherein the printing such images like a play indicia, a first bar code, and a second bar code and covered by a scratch-off material obviously includes the claimed steps of imaging (i.e., printing the play indicia, the first and second bar codes) and covering the printed images. Thus, in view of above discussion, one of ordinary skill in the art at the time of invention to use the teachings of the Patent claims as a general teaching for a lottery ticket and a method for making the same as claimed by the present application.

Thus, the instant claims obviously encompass the claimed invention of Patent No. 6,736,324.

9. Claims 1-25 and 34-41 would be allowed upon filing of the Terminal Disclaimer.

10. The following is an examiner's statement of reasons for allowance:

Royer [US 6,308,991] teaches a lottery ticket including a substrate having a first and a second side, a play area (game data area) covered by a first scratch-off material on the first sides (a first single scratch-off material on top side of lottery ticket for example), a bar code having a validation data for validating the authenticity of the lottery ticket is printed on one of the first sides (on top side of lottery ticket), and a second single scratch-off material covering the entire portion of the bar code. Wherein the first and second scratch-off material are likely the same material. The information is contained in the bar code in from of code words (form of numbers and/or symbols). The fact that the bar code symbol is an information encoded in the widths of the bars and spaces of the pattern having a predetermined height, and wherein the bar height allows redundancy by providing many possible scanning paths (i.e., the code can be optically read where only predetermined height of bars and spaces are required to scan in order to decode the bar code data), and thus the scratch-off material covering the entire portion of the code words are defined by the level of redundancy. The type of bar codes used in the teaching o f Royer is unlimited, e.g., including a notoriously old and well-known code 2D PDF format having plurality of characters or "codewords", at least one of start and stop characters, and at least of two error-correction codewords, or a 2D Data Matrix format, or any other known type of bar codes. The second scratch-off material includes human readable information printed on the second scratch-off material. The second scratch-off material is configured in a rectangular strip.

Behm [US 5,286,061] teaches a lottery ticket having a first and a second side with a play area printed on the first side of the ticket (play indicia printed within the play area of the ticket). The lottery ticket includes one or more of removable layer (i.e., a scratch-off material) affixed on the first side over the game area. The scratch-off material is configured in a rectangular strip in a horizontal configuration.

Katz [US 5,835,576] discloses a lottery ticket having a second bar code including inventory data (the bar code data defining a number corresponding to unique identification number, which would allow the retailer or the lottery system to verify the instant winner when the lottery tickets are redeemed and automatically cancel related information on the data stored in the memory) printed on the second side of the ticket and is not covered by a scratch-off material.

Koza [US 4,725,079] discloses a lottery ticket having a play area with a first indicia including validation data (integrity number) printed on one side (on front side of lottery ticket) and a second indicia printed on the other side (back side of the lottery ticket), wherein the second indicia includes inventory data and the first and second indicia are not covered by scratch-off material. The lottery ticket further includes a scratch-off material (latex covering that can be scratched off) on one of the indicia.

The examiner finds no teaching or suggestion in the prior art of the record, alone or in combination with other references, of a lottery ticket having a play area covered by a first scratch-off material on the first side, a machine readable win code printed on the first side, and a ticket identifier adapted to be read by a player ticket checker printed on the first side and wherein covering the indicia with the scratch-off material includes only covering a portion of indicia on the substrate of the lottery ticket, as set forth in the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Knapp [US 2004/0023711 A1] discloses an instant-win lottery ticket having a plurality of bar codes for authenticating the ticket and inventory information;

Colin [GB 2 171 054A] discloses a bard having a plurality of bar codes with at least portion of the bar code are partially covered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. I. Lee
Primary Examiner
Art Unit 2876